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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,585	05/28/1999	JOSH KELMAN	P-2590-1/TAC	8229

7590

05/20/2003

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55 South Commercial Street  
Manchester, NH 03101

EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

73

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/322,585

Applicant(s)

KELMAN ET AL.

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth on pg 1-3 of the instant specification in view of Reid et al (USPN 5810406). In regard to independent claim 1, the admitted prior art teaches assembling interior trim parts in which a first interior vehicle trim part is disposed adjacent a second interior vehicle trim part and in which a bead of buffer material/elastomer is provided between the first and second trim parts to reduce noises which are caused by the contact and relative movement between the edge surfaces of the adjacent interior vehicle trim parts; providing a first trim part having a peripheral mating edge configured to lie alongside a peripheral mating edge of the second trim part when the first and second trim parts are disposed adjacent one another in a vehicle--as a note, this teaching and the example of trim panels set forth on pg 1 disclose adjacent peripheral edges that are not in contact and not adhered to one another; extruding/providing a buffer material/elastomer on the mating edge of the first trim part such that the buffer material when hardened can absorb the contact and relative movements of the trim parts to reduce noises--as a note, this also illustrates the compression of the buffer material while between the trim parts; and allowing the bead

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to cure/harden before assembly of the trim parts. The admitted prior art also teaches that there is a problem with adhering elastomers to all the materials used to form automotive trim components and panels. However, the admitted prior art does not teach forming a recess having an undercut portion in the mating surface of the first trim part after providing the first trim part; providing buffer material in the recess so as to provide a bead of buffer material on the mating surface; and allowing the bead to mechanically connect to the first trim part. Reid et al teach extruding a first layer of an automotive trim part (figs 2-3); feeding the first layer into a shaping die such that the first layer has a recess with an undercut portion therein; using a mechanical bond as opposed to adhesive tapes to mate two materials to form an automotive trim (col 1, lns 10-25 and 42-50; col 2, ln 55-col 3, ln 15; figs 2-3); and providing an inner layer with a recesses which are filled and overfilled with the material of the outer layer to create a mechanical bond between the two layers (col 2, ln 55-col 3, ln 15; figs 2-3). The admitted prior art and Reid et al are combinable because they are analogous with respect to a desire to form a stronger bond between mating materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the above teachings of Reid et al to the admitted prior art in order to securely fix the buffer material of the admitted prior art, i.e., buffer material that is on the mating surface of a trim part, to the trim part.

In regard to claims 3-11, the admitted prior art also teaches using a robotically controlled applicator/extruder to provide the buffer material/elastomer to the mating edge of the first trim part--as a note, it is inherent that the applicator/extruder has an

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extrusion head and the buffer material extrudes through the extrusion head; using an elastomeric material as the buffer material; and allowing the elastomer to cure--as a note, this constitutes that the elastomer is either a thermoplastic or thermosetting elastomer. However, the admitted prior art does not teach selecting thermoplastic urethane as the buffer material; the limitations of claim 7; the limitations of claims 8-9; providing a router having a router bit; and the specific design claimed in claim 11. In regard to selecting thermoplastic urethane as the buffer material, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed method since it is not a manipulative feature or step of the claimed method. Further, the claimed material is notoriously well-known in the molding for its moldability thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed material as the buffer material of the admitted prior art in order to enhance the bond between the trim parts. In regard to the limitations of claim 7, the above combination of the admitted prior art in view of Reid et al teach using a robotically controlled extruder/applicator that is connected to a source of fluid buffer material/elastomer to provide a bead of buffer material/elastomer in the recesses of the admitted prior art (modified) and on the mating edge of the admitted prior art (modified). In regard to the limitations of claims 8-9, it is well-known in the molding art to use a recess-forming tool such as a router to form recesses in a preform and to robotically control the recess-forming tool for better control. Further, it is well-known in the molding art to combine shaping and molding operations such as cutting and extruding in order to

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reduce cycle time and complexity. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the robotically controlled applicator of the admitted prior art to include a recess-forming tool before the applicator in order to achieve the above results. In regard to providing a router having a router bit, such is a mere obvious matter of choice dependent on the equipment availability and of little patentable consequence to the claimed method since it is not a manipulative feature or step of the claimed method. Further, the use of a router with a router bit to form recesses is notoriously well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a router with a router bit to form the recesses of the admitted prior art (modified) in order to reduce the complexity of the method. In regard to the specific design claimed in claim 11, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed method since it is not a manipulative feature or of the claimed method. Further, it is well-known in the molding art to apply a buffer material to a first trim that surrounds the second trim and then assembling the trim parts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the first trim part of the admitted prior art to be the trim part that surrounds the second trim part thereby facilitating the mating and bonding of the trim parts of the admitted prior art (modified).

3. Applicant's arguments filed 3/3/03 have been fully considered but they are not persuasive. Applicant argues that there is no contact between the first and second trim parts. Such is taught by the admitted prior art set forth in the instant specification at pg

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1, Ins 18-19. Applicant also argues the use of compression between the first and second trim parts. Such is taught by the admitted prior art set forth in the instant specification at pg 1, Ins 18-28. Since trim panels are designed to be fit together closely, the buffer material are compressed in order to maintain the desired design. Applicant also argues that the recess is overfilled, Reid et al teach overfilling a recess. Though the admitted prior art does not specifically teach a step of overfilling a recess, it does teach that the buffer material must be on the peripheral edge of either trim part in order to mitigate the BSR/NVH problem. Since Reid et al addresses the problem encountered by the admitted prior art and applicant, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the above teachings of Reid et al and the admitted prior art in order to form a buffer material having the design of the admitted prior art and securely attached to at least one of the trim parts. Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **EDMUND H LEE** whose telephone number is **703.305.4019**. The examiner can normally be reached on **MONDAY-THURSDAY FROM 9AM-4PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **RICHARD CRISPINO** can be reached on **703.308.3853**. The fax phone numbers for the organization where this application or proceeding is assigned are **703.305.7718** for regular communications and **703.305.3599** for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **703.308.0661**.



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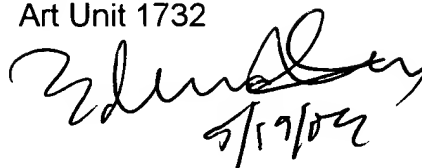
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EDMUND H LEE

Examiner

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A handwritten signature in black ink, appearing to read "Edmund H. Lee", with a date "5/19/03" written below it.

EHL

May 19, 2003